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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

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Appellant(s): McGarvey

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For Appellant

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EXAMINER'S ANSWER

BOARD OF PATENT APPEALS
AND INTERFERENCES

This is in response to appellant's brief on appeal filed
8/3/94.

(1) *Status of claims.*

The statement of the status of claims contained in the brief
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after
final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is
substantially correct. However, the description on the second and
third lines from the bottom of page 4 of the Brief that read "its

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diameter is slightly greater than, although still substantially equal to, the inner diameter of the axially farthest . .

"(emphasis added) is believed to be inconsistent with the specification and with Appellant's previous representations during the prosecution, as will be explained *infra* in this Examiner's Answer in response to Appellant' arguments concerning issue number one.

(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

(5) *Grouping of claims.*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because

(i) Appellant's grouping of claims is inconsistent with the grouping used in the final rejection, and

(ii) Appellant's brief fails to state reasons for the assertion that certain claims do not stand or fall together.

The proper grouping is:

I.) The rejection of claims 1-18 and 22 (under 35 USC §112 ¶2) stand or fall together,

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II.) The rejection of claims 19, 20 and 23 (under the doctrine of obviousness-type double patenting and 35 USC §103) stand or fall together, and

III.) The rejection of claim 23 (under 35 USC §102) stands alone.

[IV.) Claim 21 is indicated as being allowable and is not the subject of appeal.]

(6) *Claims appealed.*

The claims copied in the appendix appear to be correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

<u>Number</u>	<u>Name</u>	<u>Date</u>
5,222,747	McGarvey	June 29, 1993
4,854,597	Leigh	August 8, 1989
906,761	White	Dec. 15, 1908
89/03495	PCT'3495/Genou	April 20, 1989

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

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The following ground(s) of rejection are applicable to the appealed claims.

All grounds of rejection are set forth in ¶1-10 of the final rejection (paper #16).

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

I.) The rejection of claims 1-18 and 22 as being indefinite under 35 USC §112 ¶2, and, the determination that claim 1-18 and 22 do not read on the elected invention.

Appellant asserts that the Examiner has not "given any reason that would support a finding that any of claims 1-18 and 22 is indefinite" (pg. 7 of the Brief). However, the reasons for the rejection of these claims is clearly set forth in ¶3 of the final rejection (paper #16). The indefiniteness stems from the fact that the Examiner and Appellant disagree about the proper scope and interpretation of the claims in light of the specification and file wrapper history (M.P.E.P. §821), not that the language "substantially equal" is inherently indefinite as Appellant posits on pgs. 7-8 of the Brief.

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Appellant argues that the language "substantially equal" should be interpreted as a description of the diameters of the claimed sealing gaskets that is generic to all embodiments.

First, this broader interpretation of the claim language is not supported by the specification. The only references to the term "substantially equal" in the specification is where Appellant is seeking to distinguish the two embodiment from each other (e.g. - pg. 10, lines 21-37). The specification is devoid of any indication that the term "substantially equal" is intended to encompass both embodiments. To the contrary, the use of the term "substantially equal" is used to distinguish the slightly different diameters of the two embodiments from each other.

Second, Appellant's representations earlier in the prosecution indicate that the term "substantially equal" was not intended to be a generic expression of the embodiments. In paper #5 Appellant stated on pg. 2 of his response:

"With respect to the claims, where the small difference just described exists, the claim language "substantially equal" has been used. Where a more exact equality is present, as for example in the tightened condition shown in Fig. 1, the term "equal" has been used in the claims."

Therefore it is submitted that Appellant's current arguments that the term "substantially equal" is a broader generic expression of both embodiments is an afterthought. Appellant's interpretation

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is inconsistent with the use of the term in the specification and with Appellant's prior representations in the file history.

II.) The obviousness double patenting rejection of claims 19, 20, and 23.

Appellant admits on pg. 12 of the Brief that ordinarily it is irrelevant that the patented claim recites more features than the pending claim. Appellant then asserts the exception to this general rule, as embodied in In re Braat. However, trying to analogize the present factual situation to that the situation in Braat is like trying to fit a square peg into a round hole.

First, unlike Braat, both the present Application and prior patent were both invented by the Appellant. In Braat the Federal Circuit placed importance on the fact that since the inventors of the application and the patent were different, then there was no opportunity to include the broader claim in the earlier filed application. In re Braat, 19 U.S.P.Q.2d 1293 (CAFC 1991). In this case Appellant could clearly have sought to pursue a claim of the same scope as claims 19-20 and 23 in his prior application (S.N.# 07/694,066).

Second, this case does not present a situation where an improvement patent issues before an earlier filed basic invention. Appellant's prior '747 patent has a filing date of 5/1/91 and is essentially an improvement over his earlier

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inventions in that it includes "overtightening protection". The present application filed 8/31/92 incorporates Appellant's previously disclosed overtightening protection, and adds the additional "improvement" of using a difference in initial gasket diameter in order to obtain the desired zero dead volume, as evidenced as Appellant's designation of the present application as a "CIP" of patented application 694,066. Therefore Appellant's prior 694,066 is the broader generic application, and the present application is its improvement. This case does not fall within the Borah situation described by the Federal Circuit in Braat.

Therefore it is submitted that, unlike Braat, Appellant's attempt to extend his previously granted monopoly is unjustified, and there is no requirement that the Examiner show "two-way distinctness". Appellant does not offer a separate ground of traversal for the rejection of claim 23.

III.) The Rejection of claim 23 under 35 USC §102(b)

Appellant argues on pgs. 16-18 of the brief that the PCT'3495 reference does not disclose the tightening step, centering of the gasket, or outward expansion of the inner diameter of the gasket. These arguments are not understood in light of the specific language of the PCT'3495 disclosure. For example, PCT'3495 discloses:

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"In the tightening process self-centering of the connection 20 is insured by interaction of the tapering walls 16, 16' of the adapters 12, 13 with the tapering parts 24, 24' of the connection 20. When tightening has been completed, these tapering parts 24, 24' are restrained by the tapering walls 16, 16', . . .".

Therefore it is clear that the gasket of PCT'3495 is tightened and centered by engagement of the end formations of the tubular members with the beveled faces of the gasket. This ramping effect is the same effect claimed by Appellant to achieve the enlargement of the inner diameter of the gasket (i.e. - creation of a resultant radially outward force on the gasket). PCT'3495 clearly set forth each and every structural feature and method step set forth in claim 23. In addition, the enlargement of the inner diameter of the gasket is inherently produced by engagement of the end formations with the beveled surfaces 24, 24' of the gasket. Engagement of the sharply angled end formations 18, 18' with beveled surfaces 24, 24' is clearly sufficient to produce a resultant force that is radially outward, thereby acting to expand the inner diameter of the gasket.

IV.) The rejection of claims 19, 20, and 23 under 35 USC §103

It should be noted that with respect to the Leigh in view of White rejection, an extensive debate has already been recorded in the S.N. 07/652,225 file (which is a file-wrapper continuation of S.N. 07/392,460) in which the substance of Appellant's arguments

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have already been made and rebutted. The Board is urged to examine this file for a comprehensive discussion of this previously asserted ground of rejection.

Without repeating every word of the previous discussions on this issue, a few points are worth reiterating.

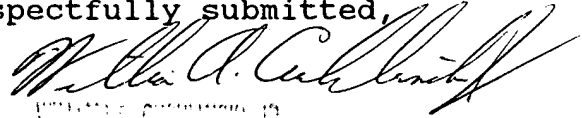
First, Appellant argues on pgs. 19, 20 and 21 that White does not disclose a semicircular bead end formation defining a zero dead volume, and is therefore deficient as a teaching reference. It should be noted that the issue is not one of anticipation. White is not required to disclose exactly every feature of Appellants invention. In addition, the critical issue is not whether the individual physical structures can be combined, but rather what the combination of references teaches when considered as a whole. Orthopedic Equipment Company v. United States, 217 U.S.P.Q. 193 (Fed. Cir. 1983); In re Sneed, 218 U.S.P.Q. 385 (Fed. Cir. 1983); In re Van Beckum, 169 U.S.P.Q. 47 (CCPA 1971). White teaches providing a seal having a gasket with "its internal diameter . . . flush with the interior of the pipe". The only logical way to accomplish this explicitly taught structural feature of White, when applied in view of the teachings of Leigh, results in the claimed structure. Such modification being obvious to one of ordinary skill in the art in light of the combined teachings of the references.

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Second, Appellant asserts on pg. 20 of the Brief that White achieves zero dead volume by providing a recess 4 in the pipes. This assertion is incorrect. White states on lines 23-26 of the specification that the recesses (4,4) are provided for the purpose of holding the parts "truly central" with each other during assembly. It is the feature of making the gasket and ends of the pipes flush upon completion of the joint that eliminates dead volume (see lines 53-58 of White), not the radially outwardly located recesses.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "William A. C. Smith".

WILLIAM A. C. SMITH
ATTORNEY AT LAW
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